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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,819	12/12/2001	Mark A. Fanton	001663	8915

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KIRKPATRICK & LOCKHART LLP  
535 SMITHFIELD STREET  
PITTSBURGH, PA 15222

EXAMINER
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KOSLOW, CAROL M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS5

**Office Action Summary**

Application No.

10/020,819

Applicant(s)

FANTON ET AL.

Examiner

C. Melissa Koslow

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspond nce address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-28 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

This action is in response to applicants' amendment of 25 July 2003. The objection to the disclosure, the objection to the claim, the 35 USC 112, second paragraph rejection, and the rejections over Van Der Zaag et al, Guillaud and Kurachi et al are all withdrawn due to the amendments to the claims and specification. Applicant's arguments with respect to the 35 USC 112, first paragraph rejection and the duplicate claim rejection have been fully considered and are persuasive. Applicant's arguments with respect to the remaining rejection have been fully considered but they are not persuasive.

Claims 22-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly claimed minor components range of at least 0.055 wt% is new matter. The specification only supports a minor components range of 0.055-0.17. The claimed range includes values greater than 0.17 wt%. Also there is no support in the specification for claiming the ferrite is free of nickel. The fact there are embodiments that are free of nickel does not support the claimed negative limitation because the presence of nickel in the ferrite is not positively recited in the specification. Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738

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F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993) is not applicable here since it is not clear from the specification that nickel cannot be present since the specification broadly discloses any manganese zinc ferrite having a Curie temperature greater than 250°C on page 4, lines 17-19, which would include those containing nickel.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7 and 9-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6-325920.

This reference teaches a ferrite consisting essentially of a main component of 30-42 mol% MnO, 4-19 mol% ZnO, the remainder Fe<sub>2</sub>O<sub>3</sub>, which is 39-66 mol%; and as secondary components, less than 1 wt% CaO, less than 1 wt% SiO<sub>2</sub> and less than 0.8 wt% Nb<sub>2</sub>O<sub>5</sub>. The taught amounts overlap the claimed amounts. Accordingly, one of ordinary skill in the art would expect the taught ferrite to have a Curie temperature range that overlaps the claimed ranges. The taught ferrite is used as the core for transformers for power systems. Thus the reference teaches the claimed core and power supply. The taught ferrite is produced by mixing of 30-42 mol% MnO, 4-19 mol% ZnO, 39-66 mol% Fe<sub>2</sub>O<sub>3</sub>, less than 1 wt% CaO, less than 1 wt% SiO<sub>2</sub> and less than 0.8 wt% Nb<sub>2</sub>O<sub>5</sub>, pressing the mixture into the desired shape, which encompassing pressing it to a predetermined density and sintering the shaped material. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re*

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*Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). One of ordinary skill in the art would expect the taught compositions that fall within the overlap to have the claimed power loss and Curie temperature, absent any showing to the contrary. The reference teaches the claimed material, core, power supply and processes.

Overlapping ranges is *prima facie* evidence of obviousness. Applicants have not presented any evidence of unexpected properties in the overlapping ranges. Applicants only has one example that falls within the composition of the reference and outside the claimed ranges (example 25). The properties of that example fall within the ranges given for the compositions that fall within the claimed ranges. The fact the reference teaches compositions outside the claimed ranges do not overcome the rejection. "As a general principle it has long been held, even where the issue was one of obviousness and not clear anticipation or description, that the comprehensiveness of a reference disclosure does not derogate from its teaching effect. "*Merck Co. v. Biocraft Laboratories Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1989); *In re Corkill* 226 USPQ 105 (Fed. Cir. 1985); *In re Susi* 169 USPQ 423 (CCPA 1971); *In re Lemin* 141 USPQ 814 (CCPA 1964); *In re Rosicky* 125 USPQ 341 (CCPA ). There is nothing in the reference to teach away from the overlapping claimed ranges in the reference (*In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997)) and there has been no showing of criticality of the claimed ranges. The rejection is maintained.

Applicants' comments with respect to undue experimentation with respect to the advantages of the claimed composition and the argued properties is given little weight since the scope of enablement of the reference is the same scope as applicants' specification. If the

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application disclosure has the same level of detail as the reference, then nonenablement arguments carry less weight. *Constant v. Advanced Micro-Devices Inc.* 7 USPQ 2d 1057 (Fed. Cir. 1988). If applicants maintain this argument, then the 35 USC 112 first paragraph rejection will be reinstated based this argument.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (703) 308-3817. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at (703) 308-3823.

The fax number for all official communications is (703) 872-9306.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661 or (703) 308-0662.

cmk  
August 28, 2003



C. Melissa Koslow  
Primary Examiner  
Tech. Center 1700